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10 **IN THE UNITED STATES DISTRICT COURT**
11 **CENTRAL DISTRICT OF CALIFORNIA**
12 **SOUTHERN DIVISION**

13 GSF Foundation, a California
14 Corporation,

15 Plaintiff(s),

16 v.

17 The Leader's Institute, LLC, a Texas
18 Limited Liability Company

19 Defendant(s).

CASE NO.:

**COMPLAINT FOR
DECLARATORY JUDGMENT**

1 Plaintiff GSF Foundation (“GSFF”), by and through its undersigned counsel,
 2 hereby alleges in its Complaint for Declaratory Judgment against Defendant The
 3 Leader’s Institute, LLC (“TLI”) as follows:

4 **PARTIES**

5 1. GSFF is a California 501(c)3 non-profit corporation with its principal
 6 place of business located at 18301 Von Karman Avenue, #1100, Irvine, California
 7 92612.

8 2. On information and belief, TLI is a limited liability company
 9 organized and existing under the laws of the state of Texas with a principal place
 10 of business at 6703 Coronation Court, Arlington, Texas 76017.

11 **JURISDICTION AND VENUE**

12 3. This Court has subject matter jurisdiction under 28 U.S.C. §§ 2201
 13 and 2202.

14 4. This action arises under the federal laws of the United States, 15
 15 U.S.C. § 1125 *et seq.*, and 15 U.S.C. §§ 1051 *et seq.*, which are within the subject
 16 matter jurisdiction of this Court under 28 U.S.C. § 1331.

17 5. On information and belief, TLI is subject to general and specific
 18 personal jurisdiction in this District based upon its purposeful, systematic and
 19 continuous contacts with the Central District of California. TLI regularly transacts
 20 business in Los Angeles, California by conducting its Build A Bike team-building
 21 bike building event in its Los Angeles, California office located at 515 S. Flower
 22 St. #3600, Los Angeles, CA 90119. See [www.leadersinstitute.com/los-angeles-](http://www.leadersinstitute.com/los-angeles-california-team-building)
 23 [california-team-building](http://www.leadersinstitute.com/los-angeles-california-team-building) attached at Exhibit 1.

24 6. On May 26, 2016, TLI sent GSFF a cease and desist letter demanding
 25 that GSFF cease using the term “build a bike” for its event that allows children to
 26 build their own bikes under the guidance and supervision of a mentor. This letter
 27 is a basis for GSFF’s claims in this action.
 28

1 7. Venue is proper in this judicial district based on 28 U.S.C. §§
2 1391(b)(2) and 1391(c) and 1391(d).

3 8. TLI purports to be the owner of U.S. Trademark Registration No.
4 4,542,884 and U.S. Trademark Registration No. 3,535,706 for BUILD-A-BIKE,
5 issued on the Supplemental Register (“the 884 Registration” and “706
6 Supplemental Registration,” respectively).

7 9. The 884 Registration states that it is for use in connection with
8 “educational services, namely, conducting classes, seminars, workshops, lectures,
9 and self-paced training programs in the field of personal and professional
10 development, leadership, communication, and team building and distribution of
11 education materials in connection therewith; personal coaching services in the field
12 of personal and professional development for individuals and groups” in
13 International Class 41.

14 10. The 706 Supplemental Registration states that it is for use in
15 connection with “education services, namely, providing classes, seminars, and
16 workshops in the field of team building and leadership,” in International Class 41.

17 11. On information and belief, TLI’s BUILD-A-BIKE program is a for-
18 profit team building activity where the participants build bikes. The adult
19 participants are divided into smaller groups to solve specific challenges in order to
20 build bicycles. See www.leadersinstitute.com/team-building/bicycle-team-building
21 attached as Exhibit 2.

22 12. On information and belief, TLI has been offering its BUILD-A-BIKE
23 team-building service since October 15, 2005.

24 13. As a result of the clearly descriptive and/or generic nature of TLI’s
25 service mark – Build-A-Bike for a team building activity where participants build a
26 bike – TLI is incapable of establishing valid trademark rights at common law or
27 through federal registration. Thus, its registrations for BUILD-A-BIKE should not
28

1 be entitled to federal trademark protection, nor should TLI be able to rely on any
2 common law rights in the designation “build-a-bike.”

3 14. GSFF, a non-profit corporation, provides strategic financial and
4 volunteer assistance to nonprofit organizations that need support in bringing hope
5 and healing to children and families in need. GSFF provides this support through
6 its various programs involving volunteer opportunities and financial donations.

7 15. One of these programs is GSFF’s bike building program which
8 purchases bicycles to donate to elementary school children in need. Each child
9 gets to build their own new bike with the help of volunteers and takes home the
10 bike, along with a helmet and lock.

11 16. GSFF’s bike building program is a private event and not open to the
12 public. GSFF does not make any money on its bike building program.

13 17. GSFF has been offering its bike building program since
14 approximately 2012.

15 18. On May 26, 2016, TLI sent GSFF a cease and desist letter accusing
16 GSFF of infringing TLI’s 884 Registration and 706 Supplemental Registration
17 through GSFF’s use of the phrase “build a bike” for its charity event that allows
18 children to build their own bikes.

19 19. In response to the cease and desist letter and without waiving any
20 rights it may have, GSFF agreed to discontinue the use of the descriptive/generic
21 term “build a bike and instead began using the descriptive terms “build ur bike”
22 and “build your bike.”

23 20. On November 14, 2016, GSFF filed a trademark application,
24 Application Serial No. 87235772, for GOLDEN STATE FOODS FOUNDATION
25 GSF BUILD YOUR BIKE and Design (“GSFF Application”), as shown below,
26 and in connection with “charitable services, namely, providing bicycles to children
27 in need.”
28



21. In an Office Action dated March 2, 2017, in connection with the GSFF Application, the Examining Attorney required that “Applicant must disclaim the following unregistrable components of the mark: (1) the wording “FOUNDATION” and “BUILD YOUR BIKE” because it merely describes an ingredient, quality, characteristic, function, feature, purpose, or use of applicant’s goods and/or services...” (see March 2, 2017 Office Action, attached hereto as Exhibit 3). GSFF intends to comply with the Examining Attorney’s requirement as it agrees that the component “build your bike” is descriptive and/or generic.

22. On December 6, 2016, TLI filed a complaint against GSFF in the Northern District of Texas, an improper venue, alleging Federal and Common Law trademark infringement and unfair competition, in addition to unjust enrichment.

23. On April 6, 2017, GSFF moved to dismiss the complaint in the Northern District of Texas for improper venue.

24. On March 27, 2017, TLI filed a Letter of Protest in the United States Patent and Trademark Office alleging a likelihood of confusion under Section 2(d) of the Lanham Act with TLI’s 884 Registration and 706 Supplemental Registration. TLI also requested a suspension of examination of the GSFF Application.

25. Because of TLI’s actions, there exists an immediate and continuing justiciable controversy between TLI and GSFF as to infringement and validity of TLI’s 884 Registration and 706 Supplemental Registration.

26. TLI’s infringement allegations threaten actual and imminent injury to GSFF that can only be redressed by judicial relief. That injury is of sufficient

1 immediacy and reality to warrant the issuance of a declaratory judgment. Absent a
 2 declaration of non-infringement and/or invalidity, TLI's continued wrongful
 3 assertions of trademark infringement with respect to GSFF's bike building
 4 charitable events will cause GSFF harm.

5 **COUNT I – DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF**
 6 **ANY VALID REGISTRATION**

7 27. GSFF re-alleges and incorporates by reference the foregoing
 8 paragraphs as though fully set forth herein.

9 28. There exists an actual and justiciable controversy between the parties
 10 as to alleged infringement of the 884 Registration and 706 Supplemental
 11 Registration.

12 29. GSFF has not infringed, and is not now infringing, any valid
 13 trademark right in the 884 Registration and/or the 706 Supplemental Registration.

14 30. GSFF's charitable services rendered under its mark shown in its GSFF
 15 Application does not infringe on any purported trademark rights that TLI has in its
 16 alleged 884 Registration and/or 706 Supplemental Registration.

17 31. GSFF's use of the terms "build ur bike" or "build your bike" to
 18 describe its bike building programs does not infringe on any purported trademark
 19 rights that TLI has in its alleged 884 Registration and/or 706 Supplemental
 20 Registration.

21 32. GSFF submits that TLI's purported trademark rights in the term
 22 "build a bike" for team building services where participants build a bike is
 23 descriptive and/or generic.

24 33. To the extent that TLI has any protectable rights in the marks shown
 25 in the 884 Registration and/or 706 Supplemental Registration, there has been and is
 26 no likelihood of confusion between TLI's use of the marks and GSFF's use of the
 27 terms "build your bike" and/or "build ur bike."
 28

34. GSFF has not, and is not now, inducing or contributing to infringement of any valid trademark right in the 884 Registration and/or the 706 Supplemental Registration.

35. GSFF is entitled to declaratory judgment in its favor that it has not infringed, contributorily infringed or induced infringement of any valid trademark right in the 884 Registration and/or the 706 Supplemental Registration.

COUNT II – DECLARATORY JUDGMENT OF INVALIDITY OF THE 884 REGISTRATION AND THE 706 SUPPLEMENTAL REGISTRATION

36. GSFF re-alleges and incorporates by reference the foregoing paragraphs as though fully set forth herein.

37. TLI's 884 Registration and 706 Supplemental Registration are descriptive and/or generic of the services used in connection with TLI'S 884 Registration and 706 Supplemental Registration for the mark BUILD-A-BIKE for team building activities where the participants build a bike.

38. GSFF is entitled to declaratory judgment in its favor that the 884 Registration and 706 Supplemental Registration are invalid and not entitled to protection under either federal or common law.

COUNT III – CANCELLATION OF THE 884 REGISTRATION AND 706 SUPPLEMENTAL REGISTRATION ON GROUNDS THAT THE MARKS ARE GENERIC

39. GSFF re-alleges and incorporates by reference the foregoing paragraphs as though fully set forth herein.

40. The 884 Registration and 706 Supplemental Registration should be cancelled as generic as the "BUILD-A-BIKE" marks covered by such registrations are generic for team building exercises where participants build a bike, and therefore are not capable of distinguishing TLI's services from the goods or services of others.

41. Pursuant to 15 U.S.C. §1119, the United States Patent and Trademark Office should be directed to rectify the Register, and to cancel the 884 Registration and 706 Supplemental Registration.

JURY DEMAND

GSF Foundation demands a trial by jury on all matters and issues triable by a jury.

REQUEST FOR RELIEF

WHEREFORE, GSF Foundation respectfully requests that this Court:

- A. Enter a declaratory judgment that GSFF does not infringe and has not infringed any valid right in the 884 Registration and/or the 706 Supplemental Registration;
- B. Enter a declaratory judgment that the 884 Registration and/or the 706 Supplemental Registration are invalid;
- C. Enter a judgment directing the United States Patent and Trademark Office to cancel TLI's 884 Registration and 706 Supplemental Registration on grounds of genericness.
- D. Declare that this is an exceptional case pursuant to 15 U.S.C. § 1117.
- E. Enter any award to GSFF of such other relief as this Court deems just and equitable.

Dated: August 3, 2017

Respectfully submitted,

BAKER & HOSTETLER LLP

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Attorneys for Plaintiff GSF Foundation

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